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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,820	10/22/2001	Shigeru Ando	Q66842	8284
7590 11/02/2005 SUGHRUE MION, PLLC 2100 Pennsylvania Avenue, NW Washington, DC 20037-3213			EXAMINER AN, SHAWN S	
			ART UNIT 2613	PAPER NUMBER
DATE MAILED: 11/02/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/982,820	Applicant(s) ANDO ET AL.	
	Examiner Shawn S. An	Art Unit 2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6, 12, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6, 12, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. As per Applicant's instructions as filed on 8/15/05, claims 2-4, and 14 have been amended, claims 1, 7-11, and 13 have been canceled, and claim 15 has been newly added.

Response to Remarks

2. Applicant's arguments with respect to amended claims 2-4 and 14 have been considered but are moot in view of the new ground(s) of rejection incorporating previously cited prior art references (see office action which follows).

As per arguments regarding claim 5, Applicant contends that due to inherent differences in the initial packaging and the subsequent processing of the films, the Seki and Shiota references are non-analogous art with respect to any teachings related to the film feeding section of Shiota and the transport device of Seki, and that modifying the invention of Seki would change its principle of operation. Therefore, one of skill in the art would not have combined the references as contended by the Examiner. Furthermore, since the principle of operation for the invention would be modified, the Examiner has not made a *prima facie* case of obviousness (MPEP 2100-132).

In response, generally speaking, Seki and Shiota references are analogous art in that they both transport film to exposure devices. Seki et al reference is used as a primary prior art reference for teaching substantial amount of Applicant's claimed limitations. Further, Shiota's reference was introduced as a secondary prior art reference for teaching at least remainder of the claimed limitations of which Seki et al's reference lacks. Seki et al discloses a film feeding section (Fig. 2, 40a) for feeding a head portion of the spliced film loaded with the film loading section, and Shiota teaches a transportation portion (Fig. 4, 40) for transporting the film to the reading transport path. Therefore, it is quite possible that the Seki and Shiota references are non-analogous with respect to specific teaching related to the film feeding section of Shiota and the transport device of Seki. Because if they were, the Examiner probably would

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have not needed/relied on Seki et al's reference to begin with, but rather only rely on Shiota's reference as a perhaps, a single 102/103 rejection. Therefore, the 103 rejection does not necessarily suggest that the both prior art references has to have substantially the same operation of the film feeding section and the transport device.

It is very possible that modifying the invention of Seki would change its principle of operation. However, it is not up to the Examiner to decide/determine the validity of combination of references as being operable or not. In rejecting claim 5, Seki et al's lacking claim limitations were taught by Shiota, and given that the both prior art reference were clearly an analogous art as discussed above, it would have been considered obvious to a person of ordinary skill in the relevant art employing an image reading apparatus as taught by Seki et al to incorporate the teachings as taught by Shiota, so that the transport merging portion is provided between the film transporting portion and the reading transport path, and the transport switching section provides a state in which the film transported by the film transporting portion is guided to the reading transport path and an another state in which the film transported from the reading transport path to the transport merging portion is guided to the film output path as an efficient way to utilize the film loader, thereby saving a significant amount of costs associated with separate hardware.

Furthermore, in response to Applicant's argument that Seki and Shiota references is non-analogous art, it has been held that a prior art reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Moreover, in response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As per Applicant's argument regarding amended claim 3, please refer to the office action which follows.

As per Applicant's argument regarding claim 6, as previously discussed in the last office action, the combination of Shiota and Seki et al does not seem to disclose an image reading section performing a prescanning film when the film is transported from a transport path and fine scanning film on the basis of image obtained by the prescanning.

However, the Examiner has taken official notice that a conventional scanning device performing a prescanning and a fine scanning are well known in the art.

Furthermore, Nakamura does teach an image reading apparatus performing a prescanning film (Fig. 4, 52) when the film is transported from a transport path (Fig. 4) and fine scanning film (54, 58) on the basis of image obtained by the prescanning (Fig. 4).

Therefore, it would have been considered obvious to a person of ordinary skill in the relevant art employing an image reading apparatus as taught by Seki et al to incorporate the teachings as taught by Nakamura so that the image reading section performs a prescanning for reading preliminary reading the image on the film when the film is transported from one end of the transport path, which could be located at a side of the transport merging portion, to another end of the reading transport path, and the image reading section fine scans for finely reading image on the film on the basis of image information obtained by the prescanning, when the film is transported from the other end of the reading transport path to the end of the reading transport path (implies obvious variation to pre scan and fine scan in the same direction, since performing pre scan and fine scan as a parallel processing are taught by Nakamura), as an efficient automatic way to scan images on the film without operator's manual intervention.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-5, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seki et al (6,056,451) in view of Shiota (5,212,512).

Regarding claim 5, Seki et al discloses an image reading apparatus, comprising:

a film autoloader (Fig. 2) for separating one photographic film from a plurality of films and supplying the film to an image reading apparatus (20) for reading image recorded on the photographic film, comprising:

a film loading section for loading a spliced film in which the plurality of films are connected in a longitudinal direction thereof (Fig. 1, 1; structure holding film reel);

a film feeding portion for feeding a head portion of the spliced film loaded with the film loading section (Fig. 2, 40a); and

a joint detecting section (Fig. 2, 82) for detecting a film joint portion between a first film and a second film in the spliced film fed from the film loading section, wherein the second film is fed next to the first film (col. 6, lines 6-15);

a film separating section (Fig. 2, 60) for separating the first film from the spliced film on the basis of information from the joint detecting section (col. 9, lines 23-43);

a film transporting portion (Fig. 2, 48) for transporting the first film separated from the spliced film by the film separation section to a reading transport path provided at the image reading apparatus (Fig. 2, 20);

a reading transportation portion (Fig. 2, elements 45 and 46) for transporting the film to the reading transport path;

an image reading section (Fig. 2, 20) for reading the image of the film that is transported along the transport path;

a film accepting section (Fig. 2, elements 49a, 49b, 49c) for accepting the film that is subject to an image reading;

a film output path (Fig. 2, see line between elements 45-46) connected to the reading transport path for guiding the film;

a film output portion (Fig. 2, 10a) for outputting the film that is transported into the film output path; and

a state in which the film transported by the film transporting portion (48) is guided to the reading transport path (Fig. 2, see line between elements 45-46).

Seki et al does not particularly disclose a transport merging portion provided between a film transporting portion and the reading transport path, and a transport switching section for switching between two states.

However, Shiota teaches a photo finishing system comprising:

a reading transportation portion (Fig. 4, 40) for transporting the film to the reading transport path;

an image reading section (87) for reading the image of the film that is transported along the transport path;

a film accepting section (86) for accepting the film that is subject to an image reading;

a transport merging portion (86) provided between a film transporting portion and the reading transport path;

a film output path (Fig. 4) connected to the reading transport path for guiding the film;

a film output portion (81) for outputting the film that is transported into the film output path;

a state in which the film transported by the film transporting portion (40, 41-42) is guided to the reading transport path; and

a state in which the film transported from the reading transport path to the transport merging portion is guided to the film output path (Fig. 4).

Therefore, it would have been considered obvious to a person of ordinary skill in the relevant art employing an image reading apparatus as taught by Seki et al to incorporate the teachings as discussed above as taught by Shiota, so that the transport merging portion is provided between the film transporting portion and the reading transport path, and the transport switching section provides a state in which the film transported by the film transporting portion is guided to the reading transport path and an another state in which the film transported from the reading transport path to the transport merging portion is guided to the film output path as an efficient way to utilize the film loader, thereby saving a significant amount of costs associated with separate hardware.

Regarding claim 2, Seki et al discloses the spliced film that is taken up in roll form in advance being loaded (Fig. 2, 1).

Regarding claim 3, as previously discussed, Seki et al does not seem to disclose a loop forming section, which is provided at a downstream side with respect to the separating apparatus along a transportation direction of the film, and by which the film transported is bent along a substantially thickness thereof so as to form a loop-shaped portion therein when another film is on the reading transport path.

However, the loop forming section is conventionally well known in the art.

Furthermore, Shiota teaches a loop forming section (Fig. 4, 81).

Therefore, it would have been considered obvious to a person of ordinary skill in the relevant art employing an image reading apparatus as taught by Seki et al to incorporate the loop forming section as taught by Shiota, to be provided at a downstream side with respect to the separating apparatus along a transportation direction of the film, and by which the film transported is bent along a substantially thickness thereof so as to form a loop-shaped portion therein when another film is on the reading transport path as a most efficient way to reserve the films.

Moreover, in response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually

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where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding claim 4, Seki et al discloses the film separation section separates the first film from the spliced film by cutting the spliced film in a vicinity of the film joint portion (col. 9, lines 23-43).

Regarding claim 12, Seki et al discloses the plurality of films are connected in series to form a continuous film (Fig. 2, 10b; abs.).

Regarding claim 15, Shiota et al discloses the transport merging portion (Fig. 4; 86, 40) being provided in an intersecting portion of a film transporting path of the film transporting portion and the reading transport path and the film output path, wherein a state in which the film transported by the film transporting portion (Fig. 4, 40, 41-42) is guided to the reading transport path, and a state in which the film transported from the reading transport is guided to the film output path, are switched by the transport switching section (Fig. 5, 43; col. 4, lines 53-68; col. 5, lines 1-21).

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seki et al (6,056,451) in view of Nakamura (6,470,101 B1).

Regarding claim 14, Seki et al discloses an image reading apparatus, comprising:

a film autoloader (Fig. 2) for separating one photographic film from a plurality films comprising;

a film loading section for loading a spliced film in which the plurality of films are spliced in series to form a continuous film in a longitudinal direction thereof (Fig. 1, 1; structure holding film reel);

a film feeding portion for feeding a head portion of the spliced film loaded with the film loading section (Fig. 2, 40a);

a joint detecting section (Fig. 2, 82) for detecting a film joint portion between a first film and a second film in the spliced film on the basis of information from the joint

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detection section, wherein the second film is disposed next to the first film (col. 6, lines 6-15);

a film separating section (Fig. 2, 60) for separating the first film from the spliced film on the basis of information from the joint detecting section (col. 9, lines 23-43); and

a film transporting portion (Fig. 2, 40b) for transporting the first film separated from the spliced film by the film separation section to a reading transport path provided at the image reading apparatus (Fig. 2, 20); and

an image reading section (Fig. 2, 20) for accepting the first film transported from the film transport path.

Seki et al does particularly disclose an image reading section performing a prescanning and a fine scanning, and wherein the image reading section takes up the photo film which has been subject to the pre scanning, which is accommodated to the film take up section, thereafter, the photo film which has been subject to pre-scanning is conveyed from the film take up section in order to be subject to the fine scanning.

However, the Examiner takes official notice that a conventional scanning device performing a prescanning and a fine scanning are well known in the art.

Furthermore, Nakamura teaches an image reading apparatus performing a prescanning film (Fig. 4, 52) and a fine scanning the film (54), and wherein the image reading section (10) takes up the photo film which has been subject to the pre scanning and the fine scanning, which is accommodated to the film take up section (48, 50) for scanning film images as necessary.

Therefore, it would have been considered obvious to a person of ordinary skill in the relevant art employing an image reading apparatus as taught by Seki et al to incorporate the teachings as taught by Nakamura so that the image reading section performs a prescanning and a fine scanning, and wherein the image reading section takes up the photo film which has been subject to the pre scanning, which is accommodated to the film take up section, thereafter, the photo film which has been subject to pre-scanning is conveyed from the film take up section in order to be subject to the fine scanning (implies obvious variation to pre scan and fine scan in the same direction, since performing pre scan and fine scan as a parallel processing are taught by

Nakamura), as thoroughly efficient way to scan the images on the film without operator's manual intervention.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seki et al and Shiota as applied to claim 5 above, and further in view of Nakamura (6,470,101 B1).

Regarding claim 6, The combination of Shiota and Seki et al does not seem to disclose an image reading section performing a prescanning film when the film is transported from a transport path and fine scanning film on the basis of image obtained by the prescanning.

However, the Examiner takes official notice that a conventional scanning device performing a prescanning and a fine scanning are well known in the art.

Furthermore, Nakamura teaches an image reading apparatus performing a prescanning film (Fig. 4, 52) when the film is transported from a transport path (Fig. 4) and fine scanning film (54, 58) on the basis of image obtained by the prescanning (Fig. 4).

Therefore, it would have been considered obvious to a person of ordinary skill in the relevant art employing a film loader for separating one film from a plurality of films and supplying the film to an image reading apparatus as taught by Seki et al to incorporate the teachings as taught by Nakamura so that the image reading section performs a prescanning for reading preliminary reading the image on the film when the film is transported from one end of the transport path, which could be located at a side of the transport merging portion, to another end of the reading transport path, and the image reading section fine scans for finely reading image on the film on the basis of image information obtained by the prescanning, when the film is transported from the other end of the reading transport path to the end of the reading transport path, as an efficient automatic way to scan the images on the film without operator's manual intervention.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Please note the new fax number.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to *Shawn S. An* whose telephone number is 571-272-7324.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SHAWN AN
PRIMARY EXAMINER

10/29/05
